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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

06530.0309

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Application Number

10/760,520

Filed

January 21, 2004

First Named Inventor

David I. FREED

Art Unit

3739

Examiner

M. Kasztejna

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets.

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

☒

attorney or agent of record.

Registration number 50,585.

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

K. Kevin Mun

Typed or printed name

571-203-2739

Telephone number

January 7, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of 1 form is submitted.

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PATENT
Customer No. 22,852
Attorney Docket No. 06530.0309

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
David I. FREED) Group Art Unit: 3739
Application No.: 10/760,520) Examiner: M. Kasztejna
Filed: January 21, 2004) Confirmation No.: 1095
For: ENDOSCOPIC DEVICE HAVING)
SPRAY MECHANISM AND)
RELATED METHODS OF USE)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests a pre-appeal brief review of this application. Claims 1-7, 10-21, 23-37, 39-53, 56-64, and 66-102 are pending, with claims 1, 34, 47, 59, 69, and 87 being independent. For the following reasons, Applicant requests withdrawal of the outstanding rejections.

35 U.S.C. § 103(a) Rejection Based on Konomura and Levinson

Claims 1-4, 10-18, 28-37, 39, 40, 43-53, 56, 58-64, 66, 67, and 97-100 are rejected under 35 U.S.C. § 103(a) based on Konomura (U.S. Patent No. 4,682,599) in view of Levinson (U.S. Patent No. 6,660,011). For the following reasons, this rejection should be withdrawn.

Independent claims 1, 34, 47, and 59 each recite, among other things, an elongated member having a proximal end and a distal end and an end effector consisting essentially of a snare loop proximate the distal end of the elongated member. The language "consisting essentially of" is a term of art that limits the scope of a claim recitation to the specified materials or steps and to those that do not materially affect the basic and novel characteristics of the claimed recitation. See, e.g., M.P.E.P. § 2111.03. Thus, the recitation "end effector consisting essentially of a snare loop" excludes any prior art end effector that includes one or more elements in addition

to a snare loop that materially affect the basic and novel characteristics of a snare loop. In this case, the end effectors of Konomura and Levinson each include at least one additional element (i.e., additional to a snare loop) that materially affects the basic and novel characteristics of a snare loop and, therefore, do not teach or suggest the recited “end effector consisting essentially of a snare loop” of claims 1, 34, 47, and 59.

For example, Konomura discloses a basket forceps assembly 1 comprising a hollow sheath 2 and a basket 3 that moves out of and into the front end of sheath 2 for holding or fracturing a foreign matter. Basket 3 comprises a plurality of resilient wires 6 and a front end tip 7 to which the front ends of wires 6 are secured. The Examiner alleges that resilient wires 6 correspond to the recited “end effector.” Applicant disagrees because, among other reasons, none of resilient wires 6 is a snare loop for severing tissue. Moreover, even assuming that one of resilient wires 6 corresponds to a snare loop, the presence of the other wires 6 materially affects the basic and novel characteristics of a snare loop because, unlike a snare loop, they must form a basket for holding or fracturing a foreign matter in the urologic tract. Therefore, the alleged end effector of Konomura does not teach the recited “end effector consisting essentially of a snare loop.”

Levinson also does not teach or suggest the recited “end effector consisting essentially of a snare loop.” Levinson discloses a device 10 for cutting and retrieving tissue. Device 10 includes an elongated tube 14 and first and second sets of wires 20, 28 slidable relative to tube 14. To cut and retrieve tissue, second set of wires 28 is first extended from the distal end of tube 14 to capture and cut tissue. Thereafter, first set of wires 20 is extended from the distal end of tube 14 to capture the cut tissue in cooperation with second set of wires 28. As is apparent, the end effector of Levinson requires both first and second sets of wires 20, 28 to enable capturing, cutting, and retrieving tissue, the features of which materially affect or otherwise alter the basic and novel characteristics of a snare loop. Therefore, Levinson also does not teach or suggest the recited “end effector consisting essentially of a snare loop.”

The combination of Konomura and Levinson therefore does not teach or suggest an end effector consisting essentially of a snare loop, as recited in independent claims 1, 34, 47, and 59.

35 U.S.C. § 103(a) Rejection Based on Konomura, Levinson, and McAlister

Claims 5-7 are rejected based on Konomura in view of Levinson and McAlister (U.S. Patent No. 5,599,324). Since claims 5-7 depend from independent claim 1 and McAlister does not supply the deficiencies of Konomura and Levinson claims 5-7 also distinguish from the cited references.

35 U.S.C. § 103(a) Rejection Based on Konomura, Levinson, and Okada

Claims 69-75, 81, 82, 89, 93, and 101 are rejected under 35 U.S.C. § 103(a) based on Konomura in view of Levinson and Okada (U.S. Patent No. 5,871,440). For the following reasons, independent claim 69 and its dependent claims patentably distinguish from the cited references.

Independent claim 69 recites a distal member defining a flow path wherein at least a portion of the flow path has a cross-sectional flow area smaller than both a cross-sectional flow area of an inlet of the flow path and a cross-sectional flow area of an outlet of the flow path. The Examiner admits that Konomura and Levinson do not disclose the claimed flow path configuration. Instead, relying on Fig. 30B of Okada, the Examiner alleges that Okada teaches a nozzle having the claimed flow path configuration and that “[i]t would have been obvious ... to vary the cross-sectional flow area in the apparatus of Konomura and Levinson in order to have greater control over the outputted flow of fluid as taught by Okada and is well known in the art.”

Konomura, however, teaches forming fluid passages in the front end tip 7 to enable continuous fluid supply when the end tip 7 closes the front end of the sheath 2. Completely different from Konomura device, Okada teaches a washing nozzle for cleaning an observation lens of an endoscope. As is apparent, the Konomura device does not include an observation lens and therefore does not need a washing nozzle of Okada or its alleged feature of “greater control over the outputted flow of fluid.” Consequently, even if the alleged teaching of Okada were available to one skilled in the art, he or she would not have modified the fluid passages of Konomura to employ the washing nozzle 372 of Okada.

Moreover, contrary to the Examiner’s allegation, washing nozzle 372 of Okada does teach any “greater control over the outputted flow of fluid” than the flow passages of Konomura. Nor has the Examiner provided any factual basis to support his allegation that such is “well known in the

art.” In fact, nothing in Okada teaches or even suggests that its washing nozzle 372 provides “greater control over the outputted flow of fluid,” as alleged by the Examiner.

The Examiner’s alleged combination of references clearly reflects impermissible hindsight gleaned from the present application. When the references are viewed without such hindsight, one of ordinary skill in the art would not have combined the teachings of Konomura and Okada simply because there would not have been any reason to do so.

35 U.S.C. § 103(a) Rejection Based on Konomura, Levinson, and Termanini

Claims 87 and 88 are rejected under 35 U.S.C. § 103(a) based on Konomura in view of Levinson and Termanini (U.S. Patent No. 4,204,528). For the following reasons, independent claims 87 and its dependent claims patentably distinguish from the cited references.

Independent claim 87 recites, among other things, a distal member defining a flow path wherein the flow path comprises an inlet and a plurality of outlets connecting to the inlet. In the rejection, the Examiner admits that Konomura and Levinson do not disclose this feature. Nonetheless, the Examiner alleges that Termanini teaches “an analogous surgical instrument having head 36 with apertures 40 to permit injection of a solution into the body during operation (See Figs. 1-2 and 6-7)” and that “[i]t would have been obvious ... to vary the outlet area in the apparatus of Konomura and Levinson in order to have greater control over the outputted flow of fluid as taught by Termanini and is well known in the art.” Applicant disagrees.

Termanini discloses a fiber-optic catheter 12 for visual inspection of the cardiovascular system. Catheter 12 includes a spray head 36 for dispersing liquid into the bloodstream to displace the blood with the clear saline for improved viewing of the vessels and organs within the cardiovascular system. As will be explained below, however, one of ordinary skill in the art would not have combined the alleged teachings of the references as proposed by the Examiner.

First, the purpose of the fluid passages in distal tip 7 of Konomura is to continuously supply fluid when the end of sheath 2 is closed with distal tip 7. Thus, these fluid passages need only allow a desired amount of fluid to be fed therethrough. Also, nothing in Konomura suggests the need for spraying fluid or “greater control over the outputted flow of fluid,” as the Examiner alleges.

So, even if the alleged teaching of Termanini were available to one skilled in the art, he or she would not have modified the fluid passages of Konomura to employ spray head 36 of Termanini.

Moreover, modifying distal tip 7 of Konomura to have a plurality of apertures, as allegedly taught by Termanini, would not serve any purpose other than complicating the design of distal tip 7 and unnecessarily requiring increased fluid pressure for injection of fluid across distal tip 7. Such adverse effects would have sufficiently deterred one of ordinary skill in the art from modifying distal tip 7 of Konomura to employ spray head 36 of Termanini.

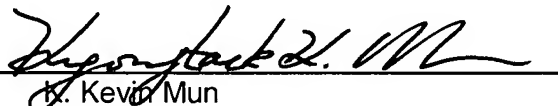
Further, contrary to the Examiner's allegation, spray head 36 of Termanini does not teach any "greater control over the outputted flow of fluid" than the flow passages of Konomura. Nor has the Examiner provided any factual basis to support his allegation that such is "well known in the art." Spray head 36 is to inject saline solution into the bloodstream to displace blood medium around it. Nothing in Termanini teaches or suggests that its spray head 36 provides "greater control over the outputted flow of fluid." Again, the Examiner's asserted combination of the cited references reflects impermissible hindsight gleaned from the present application. When the references are viewed without such hindsight, one of ordinary skill in the art would not have combined the teachings of Konomura and Termanini in the manner proposed by the Examiner.

Please grant any extensions of time required to enter this request and charge any additional required fees to our Deposit Account No. 6-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
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Dated: January 7, 2008

By: 
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